

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No. 10/024,016

ATTORNEY DOCKET NO. Q67821

AMENDMENTS TO THE DRAWINGS

FIG. 5 has been corrected to include element 50.

Attachment: Replacement Sheet(s)

REMARKS

Claims 1 and 2 are the claims that have been examined in the present application. Claims 1 and 2 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kohtani et al. (US 5,475,475) in view of Rourke (US 5,191,429). By this Amendment, Applicant is adding new claims 3 and 4.

Preliminary Remarks

Applicant thanks the Examiner for acknowledging Applicant's claim to foreign priority under 35 U.S.C. § 119 and receipt of the certified copy of the priority document.

Drawing Objection

The drawings are objected to as failing to comply with 37 C.F.R. § 1.84(p)(5) because they do not include all of the reference signs mentioned in the description.

The Examiner objects to FIG. 5 because the figure fails to include element 50. The informalities noted by the Examiner have been corrected. Thus, withdrawal of this objection is respectfully requested.

§103 Rejections

Claims 1 and 2 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kohtani et al. (US 5,475,475) in view of Rourke (US 5,191,429). Applicant respectfully traverses.

Claim 1 recites, in part:

a data output section for outputting image data after editing
by said data editing section,
wherein said data editing section edits the same number of
image data, in the event that there is an image of which size

extends over a one area when a sheet of paper is divided into said same number of areas in said same number of images represented by said same number of image data, in such a manner that a portion projected from said one area of the image of which size extends over said one area is removed and a remaining portion is recorded on said one area of the image of which size extends over said one area.

The Examiner argues that Rourke, along with Kohtani, discloses all of the elements of claim 1 of the invention. However, Rourke, which the Examiner argues discloses an image data output apparatus for outputting a plurality of pieces of image data in such a manner that a portion projected from said one image area of the image of which size extends over said one area is removed and the remaining portion is recorded on said one area of the image of which size extends over said one area, discloses the scanning of a small image, and cropping the extraneous image areas following scanning. The extraneous image areas are those areas that are darkened because the image is too small to occupy the entire scanning surface. The removal of the platen portion in Rourke does not teach or suggest the removal of a projected portion of an image which extends over the image area. Therefore, not all the elements of claim 1 are recited in the applied references.

Furthermore, there is also no motivation to combine the references. The Examiner argues that the motivation for combining the references is to enable extraneous and unwanted parts of the scanned image to be removed. The present invention does not remove extraneous and unwanted parts of the scanned image. The present invention edits a scanned image in such a manner that a portion projected over one said area is removed. Additionally, neither reference states a suggestion or teaching to combine the references. Without the proper suggestion or

motivation to combine, the references cannot render claim 1 obvious. Claim 1 is patentable over the applied references.

Claim 2 is patentable for reasons similar to those presented for claim 1. Claim 2 contains the same language regarding the portion projected over one area as claim 1. Since claim 1 should be patentable over the applied references, claim 2 is also patentable over the applied references.

New Claims


Claims 3 and 4 are patentable at least by virtue of their dependency from claim 1.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,


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